REMARKS/ARGUMENTS

1. Introduction

In the above referenced Office Action, the Examiner rejected claims 76-81 under 35 USC § 101 as being directed to non-statutory subject matter; claims 14-17, 19, 45-58, 50, 76-79 and 81 under 35 USC § 102 (e) as being anticipated by Blackketter (U.S. Patent No. 7,237,253); and claims 18, 49 and 80 under 35 USC § 103 (a) as being unpatentable over Blackketter (U.S. Patent No. 7,237,253). In addition, the Examiner rejected claims 76-81 under 35 USC § 112, second paragraph for failing to comply with the enablement requirement.

Claims 14-19, 45-50 and 76-81 are currently pending in this application. Claims 14-17, 19, 45-48, 50, 76-79, and 81 have been amended. Claims 1-13, 20-44, 51-75 and 82-93 have been canceled. The rejections above have been traversed and, as such, the applicant respectfully requests reconsideration of the allowability of claims 14-19, 45-50 and 76-81.

2. Amendments

All claims have been amended either directly or according to the claims from which they depend. Support for the amendments to all claims may be found in Figs. 1A-1D, Figs. 2A-2D, Figs. 3A-3D, and ¶¶ [0031] – [0052] corresponding thereto. Support for the criteria in the determining step, and that step occurring at the user device and independent of any request by a user for the alternate content may be found at, among other places, ¶¶[0106] and [0116]. Claims 14, 45, and 76, and families, relate to systems, processes and products for receiving at a user device an indicator signal from an interactive television service provider network indicating availability of alternate content and containing data representing an indicator form, and determining at the user device, independent of any request by a user of the user device for the alternate content, whether the indicator signal is relevant to the user, and responsive to determining that the indicator signal is relevant to the user, displaying on a screen an indication corresponding to the data representing the indicator form, wherein subject matter of the alternate content is different from subject matter of the original content.

3. 35 U.S.C. §102 Rejections

The office action applies U. S. Pub No. 7,237,353 issued June 26, 2007 to Blackketter, et. al. ("Blackketter") to all claims except 18, 49 and 80. The action contends that among other

things, Blackketter discloses determining whether a hot key signal is relevant to a user viewing original content from an interactive television service provider, citing steps 302-310 in Fig. 9 of Blackketter.

However, Blackketter relates to an interactive television device that determines whether an interactive mode is available for the current television program, and if it is, providing the interactive mode of the current television program. Specifically, Fig. 10 includes decision block 332 which shows that after a viewer requests to enter the interactive mode, the next step is "continue displaying the current television program in interactive mode." By contrast, all pending claims of the present application require that subject matter of the alternate content is different from subject matter of the original content.

Nor does Blackketter teach or suggest that the determination of whether the indicator signal, for alternate content that has subject matter different from subject matter of the original content, is relevant to the user is based at least in part on one of the following: channel presently being viewed by the user, choice of content type selected by the user, and genre selected by the user. Accordingly, applicants respectfully submit that all claims as amended define subject matter that is not disclosed or suggested by Blackketter or the other references of record, and they respectfully request that the 35 U.S.C. § 102 rejection be reconsidered and withdrawn.

4. Obviousness Rejection

The action rejected claims 18, 49 and 80 as unpatentable over Blackketter and official notice that graphics data can be preselected by a user. These claims now depend from amended claims 14, 45, and 76, which are distinguishable from Blackketter as discussed in the section above. Applicants accordingly respectfully request that, for at least this reason, the rejection of claims 18, 49 and 80 based on obviousness be reconsidered and withdrawn.

5. 35 U.S.C. § 112 Rejection

The action rejects claims 76-81 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The action notes that the preamble of each claim requires a machine readable medium, which is rendered non-enabling by ¶ [0025] of the specification. ¶ [0025] notes that "embodiments of the present invention may be provided as a computer program product which may include a machine readable medium having stored thereon

instructions ..." and that "moreover, embodiments of the present invention may also be downloaded as a computer program product, wherein the program may be transferred from a remote computer to a requesting computer by way of data signals embodied in a carrier wave or other propagation medium by a communication link." The action takes the position that the specification is non-enabling because a computer program product, which includes a machine-readable medium, cannot be downloaded as a transmission signal.

However, the language in ¶ [0025], fairly interpreted, says that (1) the computer program product may include a machine-readable medium, and (2) embodiments may also be downloaded as a computer program product by way of data signals. That language does not imply or suggest to a person of ordinary skill in the art that applicants are intending to convey that a physical disc can be downloaded as a transition signal, or that the computer program product appear in the form of a signal and as transfixed on a machine readable medium at the same time; rather, computer program products can include a machine readable medium and/or, "may also be downloaded." Among other things, it is conventional knowledge that a computer program product can be downloaded and then stored on a machine readable medium, in which case both (1) and (2) are satisfied in sequence. Applicants accordingly respectfully submit that ¶[0025] does enable a person of ordinary skill in the art to interpret the meaning of "machine readable medium," and they respectfully request that the enablement rejection be reconsidered and withdrawn.

7. 35 U.S.C. § 101 Rejections

The action rejects claims 76-81 under 35 U.S.C. § 101 as directed to non-statutory subject matter because ¶ [0025] of the specification states that a computer program product can be downloaded as a transmission signal "which is non-statutory under 35 U.S.C. § 101." Applicants respectfully submit that the language of the claim defines a computer program product, rather than a signal. Additionally, the word "signal" does not appear in any of claims 26-81. The fact that a product may be downloaded onto a computer-readable medium using signals does not negate that the product once stored on the computer-readable medium defines statutory subject matter. *See* MPEP § 2106. 01; *compare In re Nuijten,* 500 F.3d 1346 (Fed. Cir. 2007). Accordingly, applicants respectfully request that the 35 U.S.C. § 101 rejection be reconsidered and withdrawn.

8. Conclusions

For the foregoing reasons, the applicant believes that claims 14-19, 45-50 and 76-81 are in condition for allowance and respectfully request that they be passed to allowance.

The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes that such a communication would advance the prosecution of the present invention.

A petition for a two month extension of time is concurrently filed herein with a credit card form authorizing the payment of the associated fee that extends the period for response to 6/16/08. This response is timely filed. No additional fees are believed to be due. The Commissioner is authorized to charge any fees that are required or credit any overpayment to Deposit Account No. 50-2126 (ATT030073).

RESPECTFULLY SUBMITTED,

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